

## **II. REMARKS**

This response fully addresses the rejections set forth in the Office action mailed July 30, 2003. All pending claims stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claim 4 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 2, 5, 9, 10 and 11 are rejected as being anticipated and unpatentable over applied prior art. No prior art is applied against claims 6-8, 12 and 13. Applicants respectfully request that these rejections be withdrawn in view of the preceding amendments and following remarks. Applicants request reconsideration and further examination of this application as this response fully complies with the provisions 35 U.S.C. § 111.

### **A. Response To Rejections Under Section 112, First Paragraph**

In Section 3 of the Office action, the Examiner rejects all of the pending claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants maintain that the specification as filed contains a written description of the claimed invention as required by section 112. The following remarks provide the clarification requested by the Examiner in the Office action. Applicants note that the Examiner has included no specific rejections of the limitations set forth in claims 9 and 10, which depend from claim 2. Accordingly, applicants submit that the explanations provided with regard to independent claim 2 fully address the Examiner's concerns regarding claims 9 and 10. Applicants include with this response a chart that supplements the arguments below by demonstrating in tabular form where in the

specification a written description of the subject matter of the pending claims is found. This chart is attached as Appendix A. The following remarks in conjunction with Appendix A demonstrate compliance with the first paragraph of 35 U.S.C. § 112. The cancellation of claim 11 renders moot the rejection of this claim set forth in Parts cc. - ff. of this rejection. Applicants wish to note that the support provided below and in Appendix A is illustrative and the claims may be supportable by additional teachings of the specification. Applicants also wish to note that the claims of the instant application should not be construed to be limited based on the support provided. Applicants respectfully request that the rejections of the pending claims under the first paragraph of 35 U.S.C. § 112 be withdrawn for the reasons set forth below.

**1. Claim 2**

One example of the method of claim 2 is described in the sections of the specification addressing automation of intermediate transmission stations (Spec. pp. 324-389) illustrated by examples 8, 9 and 10. The method of controlling the intermediate station to transmit particular scheduled units of programming such as personalized commercial units is described in this portion of the specification.

The specification includes a written description of the step of selecting information to be associated with mass medium programming based on a schedule, where the selected information includes software as set forth by claim 2. The specification discloses the generation at the intermediate station of a program instruction set associated with a particular program unit "Q." Spec. p. 358, ll. 10-21. The program instruction set is generated at particular time interval prior to the scheduled playing of program unit "Q." Spec. p. 355, ll. 23-25. The program instruction set is among the information that is selected for transmission with program unit "Q." Spec. p. 371, ll. 11 - 35. The program instruction set includes software, as it includes computer program instructions and/or data. Spec. p. 358, ll. 20-21. This description in combination with disclosure

identified in Appendix A addresses the Examiner's request for clarification in Section 3. Part a. of the Office action (p. 2).

The specification includes a written description of the step of selecting information to be associated with mass medium programming based on a schedule, where the selected information includes video or audio as set forth by claim 2. In addition to the program instruction set, a data module set of Q is generated and associated with program unit "Q." Spec. p. 365, ll. 22-24. The data module, designated DATA\_OF.ITS, includes data for use in personalizing program unit Q including video and audio. Spec. p. 366, ll. 11-18. For example, the selected information includes binary video image information of several telephone numbers. Spec. p. 366, ll. 4-5. The DATA\_OF.ITS file may also include audio information of an announcer's voice. Spec. p. 488, ll. 24-26. This description in combination with the disclosure identified in Appendix A addresses the Examiner's request for clarification in Section 3. Parts b. and c. of the Office action (p. 3).

The specification includes a written description of the step of detecting the presence of a control signal at the transmitter station and passing the control signal to a computer, where the control signal designates at least one of mass medium programming, and information to be associated with the mass medium programming as set forth in claim 2. Upon commencing to play program unit "Q," a number of SPAM messages that are embedded in the prerecorded programming of Q are played. Spec. p. 367, ll. 33-33. Decoders at the intermediate station detect the SPAM messages that are addressed to ITS computer 73. Spec. p. 369, ll. 3-6. SPAM messages include meter-monitor segments that include a code designating the program unit to which the message pertains. Spec. p. 51, ll. 5-9. Detecting the messages causes the decoder, 77, to transfer the messages to computer, 73. Spec. p. 369, ll. 6-8. The first of these messages causes computer, 73, to generate a first outbound SPAM message that includes the DATA\_OF.ITS file. Spec. p. 369, ll. 23-26. The second of these messages causes computer, 73, to generate a second

outbound SPAM message that includes the program instruction set. Spec. p. 371, ll. 11-14. These SPAM messages thus designate program unit “Q” and also the program instruction set and data module associated with program unit “Q.” This description in combination with the disclosure identified in Appendix A addresses the Examiner’s request for clarification in Section 3. Parts d. through g. of the Office action (pp. 3-4).

The specification includes a written description of the step of controlling a selective transmission device to communicate the information to be associated with the mass medium programming to one of a selected signal generator and a signal generator at a selected time. The computer 73 is controlled to communicate the DATA\_OF.ITS file to signal generator 82. Spec. p. 369, l. 23 - p. 370, l. 7. Similarly, the computer is controlled to communicate the program instruction set to signal generator 82. Spec. p. 371, ll. 19-35. The signal generator 82 is selected from among signal generators 82, 86, and 90. Spec. p. 354, ll. 16-25. The communication of the DATA\_OF.ITS file and program instruction set occurs at the time selected to play unit Q. Spec. p. 369, ll. 3-8. This description in combination with the disclosure identified in Appendix A addresses the Examiner’s request for clarification in Section 3. Parts h. through m. of the Office action (pp. 4-5).

The specification includes a written description of the step of generating a signal containing the mass medium programming and the information to be associated with the mass medium programming. Signal generator 82 embeds a data-module-set message, including the DATA\_OF.ITS file, in the programming of Q transmission. Spec. p. 370, l. 33 - p. 371, ll. 3. Signal generator 82 further embeds a program-instruction-set message, including the program instruction set, in the programming of Q transmission. Spec. p. 372, ll. 1-6. This description in combination with the disclosure identified in Appendix A addresses the Examiner’s request for clarification in Sections 3. n. through p. of the Office action (pp. 5-6).

Applicants respectfully submit that the specification contains a written description of the invention set forth by claim 2 for the above reasons.

**2. Claim 5**

Claim 5 depends from claim 2. The specification includes a written description of mass medium programming including audio as set forth in claim 5. The program unit “Q” includes audio information. Spec. p. 357, l. 17. The specification includes a written description of a step of communicating the audio to a transmitter in accordance with the schedule as set forth in claim 5. At the scheduled time, program unit “Q” is played from recorder 76, the output of which is transferred to modulator 83, which causes the transmission of unit “Q” to field distribution system 93. Spec. p. 366, l. 19 - p. 367, l. 9. This description in combination with the disclosure identified in Appendix A addresses the Examiner’s request for clarification in Section 3. Part q. of the Office action (p. 6). Applicants respectfully submit that the specification contains a written description of claim 5 for the above reasons.

**3. Claim 6**

Claim 6 depends from claim 2. An additional example providing a written description of claim 2 is set forth in the summary example # 11 (Spec. pp. 533-557). This disclosure of the summary example #11 includes intermediate transmission stations that operate as disclosed in examples #8 and #9 used above to support claim 2 and thus supports claims 2 for the above reasons. Spec. p. 533, ll. 24-27; p. 534, ll. 28-33; p. 546, ll. 14-17.

The specification provides a written description of the mass medium programming including at least one of video, audio, and a graphic. In example 11, the broadcast programming includes picture image, sound, and print information of a crop planting plan. Spec. p. 552, ll. 20-24. This description in combination with the

disclosure identified in Appendix A addresses the Examiner's request for clarification in Sections 3. Parts r. through t. of the Office action (p. 6).

The specification provides a written description of steps set forth in claim 6. Claim 6 sets forth the step of receiving from a subscriber a response to a presentation containing at least one of video, audio, and a graphic. Claim 6 also sets forth the step of communicating second mass medium programming to transmitter based on the response. In example # 11, a presentation of a crop planting plan including picture image, sound, and print information is presented to each farmer. Spec. p. 552, ll. 20-26. The farmers modify their planting plans in response to this presentation. Spec. p. 555, ll. 14-29. Remote data collection stations receive from the farmers the modified crop planting plans. Spec. p. 555, ll. 30-34. Further programming is transmitted to the farmers responsive to the modifications. Spec. p. 556, ll. 12-18. This description in combination with the disclosure identified in Appendix A addresses the Examiner's request for clarification in Section 3. Parts u. through w. of the Office action (pp. 6-7). Applicants respectfully submit that the specification contains a written description of the invention set forth by claim 6 for the above reasons.

#### **4. Claim 7**

Claim 7 depends from claim 2. The specification provides a written description of the information to be associated with the mass medium programming including software. As set forth above with respect to claim 2, the information to be associated with the mass medium programming includes a program instruction set which includes software. Spec. p. 358, ll. 20-21. The specification also provides a written description of the step of selecting at least one of code and data. As set forth above with respect to claim 2, both the program instruction set and the DATA\_OF.ITS file are transmitted to receiver stations. Receiver stations receive the program instruction set and select and run code included therein. Spec. p. 484, ll. 7-18. Receiver stations also select and store the

DATA\_OF.ITS file. Spec. p. 482, l. 28 - p. 483, l. 2. This description in combination with the disclosure identified in Appendix A addresses the Examiner's request for clarification in Section 3. Parts x. and y. of the Office action (p. 7).

#### **5. Claim 8**

Claim 8 depends from claim 2. As set forth above with respect to claim 6, an additional example providing a written description of claim 2 is set forth in the summary example # 11 (Spec. pp. 533-557). This disclosure of the summary example #11 includes intermediate transmission stations that operate as disclosed in examples #8 and #9 used above to support claim 2 and thus supports claims 2 for the above reasons. Spec. p. 533, ll. 24-27; p. 534, ll. 28-33; p. 546, ll. 14-17.

The specification provides a written description of the step of programming the remote receiver station to select and control the communication of mass medium programming based on the schedule. In the example #11, the program instruction set controls the receiver station to select four commercial spots of particular value to the farmer. Spec. p. 551, l. 15 - p. 552, l. 8. The receiver station controls the communication of the selected commercial spots. Spec. p. 553, l. 23 - p. 554, l. 11. The local intermediate station transmits the SPAM messages and commercial information in the fashion of example #9, as discussed in with respect to claim 2, based on the schedule. Spec. p. 546, ll. 14-17; p. 547, ll. 19-26. This description in combination with the disclosure identified in Appendix A addresses the Examiner's request for clarification in Section 3, Part z. of the Office action.

#### **6. Claim 13**

Claim 13 depends from claim 6. The specification provides a written description of second mass medium programming including at least one of video, audio and a graphic. As set forth above with respect to claim 6, the optimal planting plans received by each farmer include picture image, sound, and print information. Spec. p. 552, ll. 20-

26. Second iterations of these planting plans are transmitted to the farmers. Spec. p. 556, ll. 12-18. This description in combination with the disclosure identified in Appendix A addresses the Examiner's request for clarification in Section 3. Parts aa. - cc. of the Office action (pp. 7-8). Applicants respectfully submit that the specification contains a written description of the invention set forth by claim 13 for the above reasons.

## **7. Claim 12**

One example of the transmitter station of claim 12 is described in the sections of the specification addressing automation of intermediate transmission stations (Spec. pp. 324-389) including examples 8, 9 and 10. The intermediate transmitter station shown in Figure 6 includes the elements set forth in claim 12.

The specification includes a written description of a computer means for receiving a schedule. Computer 73 as shown in Figure 6 receives a schedule. Spec. p. 326, ll. 27-33. The support for the function of the schedule is discussed in further detail with respect to claim 2 above. This description in combination with the disclosure identified in Appendix A addresses the Examiner's request for clarification in Section 3. Part gg. of the Office action (p. 10).

The specification includes a written description of a selective transmission means for detecting the presence of a control signal at the transmitter station. Decoder 77 detects a series of SPAM messages at the station shown in Figure 6. Spec. p. 369, ll. 3-8. The support for the control signal is discussed in further detail with respect to claim 2 above. This description in combination with the disclosure identified in Appendix A addresses the Examiner's request for clarification in Section 3. Part hh. of the Office action (p. 10).

The specification includes a written description of a selective transmission means for communicating information to a signal generator. Computer 73 at the transmitter station of Figure 6 functions as a selective transmission means when it selects and



transmits data to generator 82. Spec. p. 371, ll. 25-33. The support for communicating the information as claimed is discussed in further detail with respect to claim 2 above. This description in combination with the disclosure identified in Appendix A addresses the Examiner's request for clarification in Section 3. Part ii. of the Office action (p. 10).

The specification includes a written description of a signal generating means for generating a signal containing mass medium programming and information to be associated with the mass medium programming. Signal generator 82 generates a signal in which a data-module-set message, including the DATA\_OF.ITS file, is embedded in the programming of the Q transmission. Spec. p. 369, ll. 23-31; p. 370, l. 33 - p. 371, l. 3. The DATA\_OF.ITS file includes information to be associated with program unit "Q," including audio and video. Spec. p. 365, ll. 4-7; p. 488, ll. 24-26. Signal generator 82 also embeds in the programming of the Q transmission a program-instruction-set message, including the program instruction set of Q. Spec. p. 371, ll. 11 - 17; p. 372, ll. 1-6. The program instruction set includes software. Spec. p. 364, l. 25 - p. 365, l. 21. This description in combination with the disclosure identified in Appendix A addresses the Examiner's request for clarification in Section 3. Part jj. of the Office action (p. 10).

The specification includes a written description of a transmitter means coupled to the signal generating means for transmitting the signal. The apparatus that outputs transmissions over various channels through cable system field distribution system 93, including cable channel modulator 83, functions as means for transmitting signals generated by signal generator 82. Spec. p. 325, ll. 1-4; p. 370, l. 33 - p. 371, l. 3. This description in combination with the disclosure identified in Appendix A addresses the Examiner's request for clarification in Section 3. Part kk. of the Office action (p. 10).

Applicants respectfully submit that the specification contains a written description of the invention set forth by claim 12 for the above reasons.

**B. Response to Rejections Under Section 112, Second Paragraph.**

Section 4 of the Office action rejects claim 4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Office action at 11. In an effort to expedite the prosecution of this application, applicants' hereby cancel claim 4. The cancellation of claim 4 serves to render the rejection under 35 U.S.C. § 112, second paragraph, moot.

**C. Response To Prior Art Rejections**

Section 7 of the Office action rejects claim 2 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 3,627,914 to Davies (Davies). Section 8 of the Office action improperly summarily rejects claims 5, 9, 10 and 11 under 35 U.S.C. § 120(b) as being anticipated by Davies for the reasons set forth for claim 2. No reasoning is provided to support the rejections in Section 8. In apparent recognition of the weakness of the anticipation rejection based on Davies, Davies is also applied against claim 2 in combination with other references. In particular, in section 10, claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davies in view of the article "Automatic Storage and Retrieval of Videotaped Programs" by Kazama et al. (Kazama) and Japanese published application document 56-1161 listing Kamishima et al. as inventors (Kamishima). In section 11, claims 5, 9, 10, and 11 are improperly summarily rejected for the reasons set forth against claim 2 in section 10. No reasoning is provided to support the rejections in Section 11. In section 12, claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of the article "ORACLE on Independent Television" by Green and Hedger (Green), the article "The television as a receive only terminal" by McArthur (McArthur), and the paper "A Text Transmission System in Television (Text Television)" by Murasaki et al. (Murasaki). In section 13,

claims 5, 9, 10 and 11 are improperly summarily rejected for the reasons set forth against claim 2 in section 12. No reasoning is provided to support the rejection in Section 13.

As an initial matter, applicants note that no art is applied against claims 6-8, 12 and 13. Accordingly, these claims remain allowable over the art of record as set forth in the Notice of Allowability dated September 2, 1998. Applicants agree that these claims are allowable over the prior art of record. Applicants respectfully request that these claims be allowed upon withdrawal of the rejections under 35 U.S.C. § 112 for the reasons set forth above.

The cancellation of claim 11 renders the rejection of this claim moot. Applicants respectfully submit that claims 2, 5, 9, and 10 are patentable over the above identified prior art for the following reasons.

**1. Rejections Under 35 U.S.C. § 102(b) Over Davies**

Claims 2, 5, 7, 9, and 10 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Davies. For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genetech, Inc.*, 927 F.2d 1565, 1991 WL 523489 (Fed. Cir. 1991). Absence from a cited reference of any element of a claim negates anticipation of that claim by the reference. *Kloster Speedsteel AB v Crucible, Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Davies fails to teach every element of the pending claims. Accordingly, Davies fails to anticipate the rejected claims. Applicants respectfully request that the rejection based on Davies be withdrawn.

Davies is directed to an automatic television programming control system. The control system of Davies is designed to provide capabilities such as insertion of a second

video source into a main video source, background audio, and transitions from one source to another. Davies col. 1, ll. 43-54. Davies does not address inserting any other information in signals with mass medium programming.

Claim 2 sets forth a method of controlling a transmitter station that results in the transmission of a signal containing mass medium programming and information to be associated with the mass medium programming. Applicants' specification provides numerous examples of signals that contain information for future association with mass medium programming. Such information includes data that is processed at a receiver station to create personalized content that is associated at the receiver station with programming that is output to the mass audience. In Section 5 of the Office action, it is acknowledged that Davies is cited as being illustrative of conventional automated television studios. Office action at 13. Conventional television studios merely broadcast mass medium programming. Signals from conventional television studios do not include additional information for future association with the mass medium programming. Davies includes no teaching to suggest that anything other than conventional television programming is broadcast. Accordingly, Davies fails to every element of claim 2.

The method of claim 2 includes the step of selecting information to be associated with the mass medium programming based on a schedule. This step is not shown in Davies. In the Office action, the selection of background audio is relied upon to show information to be associated with mass medium programming. In Davies, a television program is divided into events that are characterized in a defined manner that permits the events to be stored in the memory of the automatic control system. Davies col. 1, ll. 62-73. The background audio is merely one characteristic of an event of the television programming sequence. Davies col. 2, ll. 71-75. In other words, the background audio is a part of the mass medium programming that is output by the Davies system. It is not information *to be* associated with mass medium programming because it is an inseparable part of the programming for broadcast by the Davies system. Davies like any

conventional television programming controller merely puts together parts of the actual mass medium television programming. Davies fails to teach selecting information *to be* associated with mass medium programming.

The method of claim 2 includes the step of generating a signal containing the mass medium programming and the information to be associated with the mass medium programming. Claim 2 also includes a step of transmitting the generated signal. Davies does not show these steps because, as discussed above, Davies does not teach information *to be* associated with the mass medium programming. The step of generating a signal that contains both mass medium programming and the information *to be* associated with mass medium programming emphasizes that the information is not yet a part of the mass medium programming in the signal that is transmitted. In contrast, the background audio is a part of the television program output by the Davies system. The Office action relies on mixer 74 of Davies to generate the signal. Office action at 16. However, the Office action acknowledges that the mixed audio signal contains both the full audio and the background audio. Office action at 16. As the audio signals are combined, there is no information left *to be* associated with mass medium programming. At best, Davies generates mass medium programming. No signal is generated and transmitted that separately includes information *to be* associated with the mass medium programming. This is consistent with the characterization of Davies as showing a conventional television studio.

Claim 2 includes a step of controlling a selective transmission device to communicate the information to be associated with the mass medium programming. This step is not taught by Davies for the reasons discussed above. Davies does not teach information *to be* associated with the mass medium programming for the reasons set forth above. Accordingly, Davies does not teach controlling a selective transmission device to communicate such information.

Claim 2 includes a step of detecting the presence of a control signal. The control signal is defined as designating at least one of the mass medium programming and the information to be associated with the mass medium programming. In the Office action, the output of real time clock 26 in Davies is relied upon to show a control signal. There is no teaching in Davies that the output of real time clock 26 in Davies designates anything other than the current time. Davies col. 3, ll. 59-70. The output of real time clock 26 is completely independent from, and does not designate, mass medium programming or any other information. This deficiency of the Davies reference is acknowledged in Section 10 of the Office action where Davies is applied in combination with other references that are applied in an attempt to show a control signal.

Davies fails to teach every element of claim 2 for at least the reasons set forth above. Accordingly, applicants respectfully submit that the rejection of claim 2 under 35 U.S.C. § 102(b) is improper and should be withdrawn.

Section 8 of the Office action includes a single sentence rejecting claims 5, 9 and 10 under 35 U.S.C. § 102(b) as being anticipated by Davies for the reasons set forth for claim 2 above. This rejection is improper as it fails to consider the elements of claims 5, 9 and 10. *See* M.P.E.P. § 2131. The rejection of claims 5, 9 and 10 should be withdrawn for this reason alone.

Claims 5, 9, and 10 depend from claim 2. As these claims include the limitations of claim 2, Davies fails to anticipate these claims for at least the reasons set forth above with respect to claim 2. Moreover, claim 10 further sets forth the steps of receiving and storing the information to be associated with the mass medium programming. As Davies fails to teach information to be associated with the mass medium programming as set forth in claim 2, Davies cannot teach receiving and storing such information. Davies fails to teach every element of claims 5, 9 and 10 for at least the reasons set forth above. Applicants respectfully submit that the rejections of claims 5, 9 and 10 under 35 U.S.C. § 102(b) are improper and should be withdrawn.

## 2. Rejections Under Section 103

In addition to asserting that Davies anticipates claims 2, 5, 9 and 10, the Office action applies Davies in combination with two sets of references under 35 U.S.C. § 103(a). To establish a *prima facie* case of obviousness under § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all of the claim recitations. M.P.E.P. § 706.02(j) (8<sup>th</sup> ed. 2001). Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to support a § 103 rejection based on a combination of references, the Examiner must provide a sufficient motivation for making the relevant combinations. *See* M.P.E.P. §§ 2142 and 2143.01; *see also In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.”). It is well-settled that an Examiner can “satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some *objective teaching* in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (emphasis added); *see also In re Lee*, 277 F.3d 1338, 1344; 61 USPQ2d 1430, 1434 (Fed. Cir 2002) (“‘deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense’”). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence [of a motivation to combine]’” and thus do not support rejections based on

combining references. *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Without objective evidence of a motivation to combine, the obviousness rejection is the “essence of hindsight” reconstruction, the very “syndrome” that the requirement for such evidence is designed to combat, and without which the obvious rejection is insufficient as a matter of law. *Id.* at 999, 50 USPQ2d at 1617-18.

As set forth in greater detail below, the Examiner has failed to follow these requirements when rejecting claims 2, 5, 9 and 10, under 35 U.S.C. § 103. For this at least this reason, the § 103 rejections should be withdrawn.

**a. 35 U.S.C. § 103 (a) Rejection Based On  
Davies In View Of Kazama and  
Kamashima**

In Section 10 of the Office action, claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of Kazama and Kamishima. The Office action fails to establish a *prima facie* case of obviousness for at least two reasons. First, Davies fails to show or suggest information to be associated with mass medium programming as set forth in claim 2. The secondary references to Kazama and Kamishima do not address this deficiency of the primary reference. Second, the combination of Kazama and Kamishima with Davies is improper.

Claim 2 includes the following steps directly related to the information to be associated with the mass medium programming:

selecting information to be associated with mass medium programming based on a schedule,

controlling a selective transmission device to communicate the information to be associated with the mass medium programming,

generating signal containing the mass medium programming and the information to be associated with the mass medium programming, and

transmitting the signal.



Davies does not show or suggest information to be associated with the mass medium programming for the reasons set forth above with regard to the rejection under 35 U.S.C. § 102. Accordingly, Davies does not show or suggest these steps set forth in claim 2. The Office action does not assert that Kazama or Kamishima corrects this deficiency of the primary reference. Neither Kazama nor Kamishima suggests information to be associated with mass medium programming.

Claim 2 includes the step of detecting the presence of a control signal. The control signal is defined as designating mass medium programming or information to be associated with mass medium programming. The Office action relies on Kazama and Kamishima to show the control signal.

Kazama is directed to an automatic, computer controlled tape-traffic and handling system. The system delivers videotapes to designated playback machines. To prevent possible mistakes, a broadcast control system reads out a program's registered code number recorded on the head of the tape and compares it with a number in the program time table. Kamishima is directed to a device that automatically monitors the operation of a switching system through program source codes applied to video signals and codes sample values applied to audio signals.

Neither Kazama nor Kamishima describe control of a transmitter station. In the Office action, it is asserted: "it would have been obvious to one of ordinary skill in the art to have coded the programming that was broadcast within the automated switching system disclosed by Davies with program identifying control which would be monitored by the switching computer, compared to the stored broadcast schedule, and used *advantageously* to prevent the various types of transmission errors described in Kazama et al. and/or Kamishima et al." To the contrary, the coded programming would have no benefit in the system disclosed by Davies. In the Davies system, various sources for video and audio are turned on and off at scheduled times. Davies includes no teaching regarding identifying the program elements. Davies does not disclose any switching

computer that could employ program codes. Accordingly, there is no suggestion to employ any coded programming from Kazama or Kamishima in the Davies system. Furthermore, assuming coded programming was used in the Davis system, it would have no effect as the Davies system includes no elements that could detect such codes.

There is no motivation or suggestion found in the prior art to combine the teachings of Davies with the teachings of Kazama or Kamishima. Moreover, these three references fail to show or suggest every element of claim 2. For at least these reasons, applicants respectfully request that the rejection of claim 2 as being unpatentable over Davies in view of Kazama and Kamishima be withdrawn.

Section 11 of the Office action includes a single sentence rejecting claims 5, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of Kazama and Kamishima for the same reasons set forth for claim 2 above. This rejection is improper as it fails to consider the elements of claims 5, 9 and 10. *See* M.P.E.P. § 2143.03. The rejection of claims 5, 9 and 10 should be withdrawn for at least this reason.

Claims 5, 9 and 10 depend from claim 2. As these claims include the limitations of claim 2, Davies in view of Kazama and Kamishima fails to render these claims obvious for at least the reasons set forth above with respect to claim 2. Moreover, claim 10 further sets forth the steps of receiving and storing the information to be associated with the mass medium programming. As Davies fails to teach information to be associated with the mass medium programming as set forth in claim 2, Davies does not teach receiving and storing such information. There is no suggestion that the secondary references to Kazama and Kamishima correct this deficiency of the primary reference. Davies in view of Kazama and Kamishima fails to show or suggest every element of claims 5, 9 and 10 for at least the reasons set forth above. Applicants respectfully submit that the rejections of claims 5, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of Kazama and Kamishima are improper and should be withdrawn.

**b. 35 U.S.C. § 103 (a) Rejection Based On  
Davies In View Of Green, McArthur and  
Murasaki**

In Section 12 of the Office action, claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of Green, McArthur and Murasaki. The Office action fails to establish a *prima facie* case of obviousness against claim 2. As an initial matter, applicants note that the rejection presented in Section 12 relies on no specific teaching from McArthur. Applicants respectfully request that the specific teaching relied upon from this reference be identified or that this reference be withdrawn from the rejection.

Claim 2 includes the step of selecting information to be associated with the mass medium programming based on a schedule. The schedule designates mass medium programming and includes a time or a channel on which to transmit the mass medium programming. The Office action relies on a combination of Green and Davies to show this feature. The Office action provides no suggestion or motivation as why one of ordinary skill would combine the teachings of these references. Furthermore, neither Green nor Davies suggests this feature.

Green is directed to the ORACLE text news delivery service employed by the Independent Television Companies in Britain. The ORACLE system employs the television distribution system to deliver text data. The teletext data is inserted in the video signal. The ORACLE system is designed primarily to provide news independently from the television programming with which it is broadcast. However, the system may be used to provide program related information that provides a back-up to normal television programming. This program related information may include summaries of plays, cast lists for films, and details of books for adult education.

In the Office action, it is asserted that because some of the pages of teletext information include program related information they must be selected and scheduled for transmission based on the scheduled television programming with which it is associated.

The selection of program related information may be selected based on its related program. However, there is no suggestion in Green that the selection is based on a schedule that designates the related programming. There is no suggestion in Green that the teletext is selected based on any schedule of television programming. Program related teletext pages may be scheduled independently from its related program. Green does not teach selecting teletext based on a television program schedule. In fact, Green suggests that even where the ORACLE system is used for subtitling, the teletext is stored with its own schedule in the form of time cues. Green at 27. Green does not suggest selecting teletext to be associated with television programming based on a schedule designating the television programming as implied by the Office action.

Moreover, there is no motivation or suggestion in the applied art to combine the automatic television program control system of Davies with the ORACLE system of Green. The Office action identifies no motivation to combine these references. There is no teaching in the prior art regarding how to modify the system disclosed by Davies to distribute teletext in the manner of Green. The Examiner has selected two disparate references to in an attempt to identify different elements of claim 2. The only similarity between the references is that they relate to television signals. There is no objective teaching available to one of skill in the art at the time the invention was made to combine the teachings of Davies and Green.

The secondary reference to Murasaki is relied upon to show a teletext inserter and a transmitter. The Office action fails to set forth how to modify the teachings of either Davies or Green with the teaching of Murasaki to arrive at the invention set forth in claim 2. The Office action identifies no motivation or suggestion to combine the teaching of Murasaki with the primary reference to Davies. There is no teaching how the mixer or transmitter of Murasaki could be used to modify the system set forth in Davies.

Claim 2 includes the step of detecting the presence of a control signal. The control signal designates the mass medium programming or the information to be

associated with the mass medium programming. In the Office action, it is asserted that real time clock 26 of Davies detects real time control signals. To the contrary as discussed above with respect to rejection of claim 2 under Section 102, the real time clock merely supplies the current time. No signal from the real time clock designates any programming or information. There is no suggestion, in the Office action or the applied art, that the secondary references correct this deficiency of Davies.

There is no motivation or suggestion found in the prior art to combine the teachings of Davies with the teachings of Green, McArthur or Murasaki. These applied references fail to show or suggest every element of claim 2. For at least these reasons, applicants respectfully request that the rejection of claim 2 as being unpatentable over Davies in view of Green, McArthur and Murasaki be withdrawn.

Section 13 of the Office action includes a single sentence rejecting claims 5, 9, 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of Green, McArthur, and Murasaki for the same reasons set forth for claim 2 above. This rejection is improper as it fails to consider the elements of claims 5, 9 and 10. *See* M.P.E.P. § 2143.03. The rejection of claims 5, 9 and 10 should be withdrawn for at least this reason.

Claims 5, 9 and 10 depend from claim 2. As these claims include the limitations of claim 2, Davies in view of Green, McArthur and Murasaki fails to render these claims obvious for at least the reasons set forth above with respect to claim 2. Applicants respectfully submit that the rejections of claims 5, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Davies in view of Green, McArthur and Murasaki are improper and should be withdrawn.

#### **D. Issues Not Related To Pending Claims**

Applicants respectfully submit that the pending claims are allowable for the reasons set forth above. The above arguments reply to every objection and rejection in

the Office action. Accordingly, no further response is necessary to comply with 35 U.S.C. § 111. However, the Office action raises a number of other issues not relevant to the claims pending in this application.

In Section I of the Office action, the Examiner asserts that the claims pending in this application are only entitled to an effective filing date of September 11, 1987. As the Office action relies only on references available prior to applicants earliest filing date, the effective filing date of the pending claims is not relevant to any rejection in the Office action.

In Section 2 of the Office action, the Examiner notes that same issues have been raised in different ones of applicants' copending applications. The Examiner refers to a "list" in Appendix III of positions held by the Examiner regarding such overlapping issues. There is no explanation regarding how any of the issues presented in the "list" are relevant to the claims pending in this application. In fact, many Examples presented in the list rework the Examiner's position regarding 35 U.S.C. § 120. Other Examples address specific claim language not present in the claims pending in this application and art not applied against the claims pending in this application.

In Section 14 of the Office action, the Examiner refers to Appendix IV of the Office action, which provides a summary of what the Examiner considers the more pertinent prior art of record. The summary in Appendix IV is helpful to appreciate the Examiner's current understanding of the teachings of the art of record. Applicants will fully respond to the Examiner's assertions should they be used to reject any claims.

Applicants note that these sections of the Office action neither present nor support any objection or rejection regarding the claims pending in this application. Applicants respectfully submit that these sections do not advance the prosecution of this application and should be withdrawn in their entirety.

**E. Response To Section 1 Of The Office Action**

In Section I of the Office action, the Examiner asserts that the claims pending in this application are only entitled to an effective filing date of September 11, 1987. Although applicants' original parent application was filed November 3, 1981, the effective filing date is not at issue in the prosecution of this application. The effective filing date of the pending claims is irrelevant because the Examiner has applied no art from the intervening time period after November 3, 1981. Furthermore, applicants acknowledge that they will not rely on the November 3, 1981 date to overcome any rejection of the claims in this application during prosecution before the Office. Notwithstanding, the Examiner has referred to Appendix I of the Office action in which the Examiner sets forth his understanding of the requirements of 35 U.S.C. § 120. Appendix I further refers to Appendix II, which purports to identify significant differences and inconsistencies between the specifications filed by applicants in 1981 and 1987. These appendices are not relevant to the prosecution of the claims pending in this application. Applicants have fully addressed the proper application of 35 U.S.C. § 120 in those copending applications where the issue is relevant. Applicants do not agree with the Examiner's characterization of the requirements of 35 U.S.C. § 120 or of applicants' specifications. However, applicants note that 35 U.S.C. § 120 is properly applied on a claim by claim basis. As the effective filing dates of the claims in this application are not at issue, the Examiner's arguments set forth in Appendices I and II cannot properly be addressed in this application. Applicants reserve the right to fully address the Examiner's characterization of the requirements of 35 U.S.C. § 120 set forth in Appendix I and the Examiner's characterization of applicants' specification set forth in Appendix II should the Examiner properly assert these arguments against any of applicants' pending claims.

**F. Response To Section 2 Of The Office Action.**

In Section 2 of the Office action, the Examiner refers to a list of positions held by the Office regarding issues that may have been raised in different ones of applicants'

compending applications. The “list” is presented in Appendix III of the Office action. The Examiner alleges that in some cases applicants have “handled and addressed” these issues inconsistently in different applications. The Examiner states that the “list” will be maintained by the Office “in an attempt to ensure that the issues are in fact handled consistently among the related applications.” Office action, p. 2.

Applicants respectfully submit that the “list” is irrelevant to the prosecution of the instant application for a number of reasons. The Patent Office itself has acknowledged that the list is not relevant to certain applications because applicants have not asserted priority in those applications to the filing date of applicants’ 1981 application:

It is examiners position that after a series of interview, it has been mutually agreed upon that the instant application is entitled the earlier priority date of 9/11/87 based on the 07/096,096 application and not the 11/3/81 date based on the 06/317,510 application. Therefore, the written description and the enablement under 112 1<sup>st</sup> paragraph should be limited to the 1987 specification only. Additionally, the remarks set forth in Paragraph III, items 1-30 [the “Examples”] of the instant office action are carried over from other office actions in similar cases and are presented herein because in the past there have been disagreements between the priority date that the applicants are entitled to. The examiner will withdraw paragraph III from subsequent actions in the instant case application if applicants confirm on record in the next communication that the instant application is entitled to only the 1987 priority date and the citations for claim support will be only provided for the 1987 specification.<sup>1</sup>

The Examiner’s position that he will withdraw the irrelevant 30 Examples only if “applicants confirm on record in the next communication that the instant application is entitled to only the 1987 priority date” is improper. Whether or not *a particular claim* is

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<sup>1</sup> This paragraph was included in Office actions in the following applications: 08/487,397 mailed 9/06/02; 08/438,011 mailed 9/06/02; 08/447,496 mailed 9/06/02; and 08/479,215 mailed 9/05/02.



afforded the benefit of an earlier filing date under § 120 simply depends on whether the requirements of § 120 are met *for that claim*. A claim either is or is not entitled to an earlier filing date, and such a determination cannot be made without conducting the appropriate claim-by-claim analysis required by the controlling authorities. Of course, it is applicants' decision whether or not to invoke § 120 in order to overcome an intervening reference. In the instant application, applicants have distinguished the teachings of the intervening references applied by the Examiner on the merits and have *not* invoked § 120 to avoid the intervening references. Moreover, applicants have demonstrated specification support herein only with respect to the 1987 specification. Accordingly, the "list" should be withdrawn.

Applicants question the relevance of the "list", as well as applicants' need to respond to these Examples, because none of the examples forms the basis for any objection to or rejection of a pending claim. *See* 37 C.F.R. § 1.111 ("In order to be entitled to reconsideration or further examination, the applicant . . . must reply to every ground of objection and rejection in the prior Office action."). Further, none of the examples in the list refers to any claims that are presently pending in the instant application. Accordingly, the Examples simply have no bearing on the prosecution of the claims pending in the instant application, and are therefore improper.

Applicants further question the basis for including the "list" in the instant application and applicants' need to respond to the Examples, because the vast majority of the Examples have appeared at least once before in other applications and because applicants have already responded to the vast majority of the Examples on the record in their copending applications. As the Examiner has stated the "list" has been presented in many actions issued in applicants' related copending applications. As these issues have been fully addressed where relevant to applicants' claims, there is little to be gained by littering the record of the instant application with exhaustive responses to issues not directly relevant to rejection of the claims presented herein. Applicants have at all times

strived to respond in a consistent manner in all of applicants' copending applications. Accordingly, applicants believe that the Examiner is mistaken in his assertion that applicants have "handled and addressed" the issues raised in the list "inconsistently."

The issues raised in the "list" are not relevant to the instant application, and applicants respectfully request that the "list" be withdrawn and that the Examiner acknowledge the lack of relevance of the "list" to the prosecution of the instant application. Notwithstanding applicants' position regarding the lack of relevance of the "list" to the prosecution of the instant case, applicants provide the following responses<sup>2</sup> to the "list". Applicants reserve their right to further address any of the issued addressed in the "list" if, for example, they are ever raised in the context of an actual rejection or objection.

### **Examples 1-3**

Examples 1-3 address various issues concerning applicants' ability to claim priority to their 1981 application and the proper test for demonstrating priority under 35 U.S.C. § 120. Because applicants have not asserted priority to their 1981 application for any of the pending claims in the instant application, Examples 1-3 are wholly irrelevant to the instant application.

In Example 1, the Examiner discusses prosecution of applicants' copending application Ser. No. 08/470,571. More specifically, the Examiner focuses on the need to first demonstrate written description support in applicants' 1987 specification when claiming priority under § 120. Applicants have not asserted priority under § 120 to the date of their 1981 application for any of the pending claims in the instant application, and applicants have identified detailed written description support in their 1987 specification

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<sup>2</sup> More detailed responses to many of the Examples appear in, among other places, applicants' 01/28/02 Response, 05/06/02 Response to Interview Summary, and 01/09/03 Response filed in the '571 Application.

for each and every pending claim in the instant application in Appendix B. Further, applicants respectfully disagree with the Examiner's characterization of their position regarding priority in their copending applications. Finally, in addition to being totally irrelevant to the instant application, applicants submit that the assertions made by the Examiner in Example 1 are improper in the absence of any priority claim made by applicants under 35 U.S.C. § 120 to their 1981 application for any claim in the instant application.

In Example 2, the Examiner takes issue with applicants' discussion and position regarding the proper test for demonstrating priority under § 120. Again, the Examiner refers to applicants' responses filed in the '571 Application. Although applicants continue to disagree with the Examiner's description and application of the legal test for demonstrating priority under § 120 (for the detailed reasons set forth by applicants, e.g., in their 01/09/03 Response in the '571 Application), the issue of priority under § 120 is simply not an issue in the instant application.

In Example 3, the Examiner further discusses applicants' ability to demonstrate priority under § 120 and their ability to support claims pending in the '571 Application using applicants' 1987 specification. Applicants believe that the issues raised in Example 3 are irrelevant to the instant application and submit that the Examiner has mischaracterized applicants' position regarding their ability to demonstrate written description support in both the 1987 and 1981 specifications for the claims pending in the '571 Application and other applications in which applicants are asserting priority under § 120.

Applicants' positions with respect to the various issues related to applicants' ability to claim priority to the date of their 1981 specification and the proper legal test for demonstrating priority under § 120 has been discussed in detail in applicants' submissions in the '571 Application. Applicants will continue to provide the factual and legal bases that justify their claim of priority to their 1981 application in those copending

applications where such claim is appropriate and necessary (i.e., if intervening art is applied and applicants elect to invoke § 120 to overcome such intervening art).

#### **Example 4**

In Example 4, the Examiner discusses a claim limitation (i.e., “locally generating” images) relevant to certain claims pending in applicants’ ‘571 Application. Applicants respectfully disagree with the Examiner’s assertion in Example 4 that Teletext decoders locally generate images for output or display in the same manner that is being claimed in certain ones of applicants’ copending applications, and applicants have already addressed the issue of whether the prior art applied by the Examiner teaches local generation of images in the ‘571 Application. If the Examiner bases a rejection of or objection to any claim pending in the instant application on the issues found in Example 4, or asserts that the issues found in Example 4 are in any way relevant to the instant application, applicants will address any such assertions at the appropriate time.

#### **Examples 5 and 27**

In Examples 5 and 27, the Examiner discusses the “Teletext prior art” and the inventions disclosed in applicants’ 1987 specification in the context of an Office action and a Response filed in the ‘571 Application. The Examiner asserts in Examples 5 and 27 that applicants’ 1987 “packetized SPAM” structure represents little more than applicants’ own version of a “conventional extended Teletext system.” In Example 27, the Examiner further asserts that certain structures recited in some of applicants’ claims pending in the ‘571 Application (namely, a receiver, a signal detector, a processor, and an output device) are also “found within a conventional CPU/MP/computer implemented Teletext” receiver. These examples are not discussed or applied in the context of any of the claims pending in the instant application and the Examiner does not reject any of the pending claims based on the arguments made in Examples 5 and 27. If and when the Examiner makes rejections of specific pending claims on the basis of issues raised in Examples 5

and 27, applicants will further respond to such a rejection. Notwithstanding the lack of relevance of Examples 5 and 27 to this application, applicants strenuously disagree with the Examiner's disparaging assertions and characterization of the subject matter disclosed in applicants' 1987 specification. Finally, applicants note that they have previously addressed how applicants' claims differ from many "Teletext" prior art references in prior responses filed in copending applications.

#### **Example 6**

In Example 6, the Examiner discusses applicants' ability to obtain priority to their 1981 filing date for claiming "computer software." The Examiner discusses this issue with respect to arguments advanced in applicants' '571 Application related to applicants' prior use of the term "programming" in claims pending in the '571 Application. Applicants have fully addressed the issues raised in Example 6 in the '571 Application. The issues raised in Example 6, however, are not relevant to the instant application because applicants have not asserted priority under § 120 to the date of their 1981 application for any of the pending claims in the instant application. In fact, in Example 6, the Examiner acknowledges that applicants' 1987 specification does disclose the downloading of computer software. Notwithstanding the lack of relevance of Example 6 to this application, applicants disagree with the Examiner's position regarding applicants' ability to obtain priority to their 1981 filing date for claims that include the term "programming."

#### **Example 7**

In Example 7, the Examiner alleges that Teletext decoders found in the prior art are "signal processors" as the term "signal processor" is used within the context of applicants' claims pending in the '571 Application. Again, the issues raised in Example 7 are not discussed in the context of any claim currently pending in the instant application. Applicants do not understand the relevance of Example 7 to any of the

claims currently pending in the instant application and no attempt is made to apply the discussion in Example 7 to the instant claims. Notwithstanding the lack of relevance of Example 7 to this application, applicants respectfully disagree with the Examiner's assertions and characterization of Teletext decoders found in the prior art and the signal processor disclosed by applicants. Applicants submit that the signal processors disclosed in applicants' specifications perform functions that are not disclosed in the cited Teletext prior art references. Finally, applicants will address these issues if and when an actual rejection is made by the Examiner based on the issues raised in Example 7.

### **Example 8**

In Example 8, the Examiner asserts that it is applicants' position that applicants' claimed/disclosed technology is not "correlated/analogous" to Teletext technology. The Examiner, however, fails to provide any details regarding his position that "conventional Teletext systems" generally are correlated or similar to applicants' claimed technology. Indeed, such generalized "correlations" or "analogies" are wholly irrelevant to the issue of whether or not applicants' claims are patentable. Applicants' position is that none of the specific references, related to Teletext or otherwise, alone or in combination, teach the methods and apparatus claimed by applicants. The Examiner further argues that applicants have previously indicated it is their belief that the scope of many of their pending claims encompasses the "Weather Star" system/receiver technology. First, the question of whether or not a particular system would be covered by a pending claim is wholly irrelevant to the examination of the instant claims, unless such system is prior art. The Examiner has not established that the Weather Star system is prior art. Second, although the Examiner vaguely refers to applicants' "pending amended claims," he makes no reference to a specific application *or a specific claim*. Due to the Examiner's broad treatment of these issues, applicants cannot respond in any meaningful manner to the issues raised in Example 8.

### **Example 9**

In Example 9, the Examiner discusses an issue that arose in the prosecution of the '571 Application regarding whether “digital television signals/programming” was well known in the relevant art at the time that applicants filed their specifications. In their 1/28/02 Response filed in the '571 Application, applicants fully addressed the Examiner's rejections under § 112, second paragraph, of claims with limitations of “digital television.” Further, applicants maintain their position stated in the '571 Application regarding the Schwartz et al. reference. Applicants note that there are no rejections of or objections to any of applicants' pending claims in the instant application based on the issues raised in Example 9, and applicants reserve the right to further respond to the issues raised in Example 9 if any of these assertions are relied on to object to or reject any claim in the future.

### **Example 10**

In Example 10, the Examiner discusses two references of Zaboklicki: DE 2,914,981 and GB#2,016,874. Despite the Examiner's characterization of applicants' arguments regarding these references, applicants maintain that neither Zaboklicki reference anticipates or renders obvious any of applicants' pending claims in the instant application. Applicants have previously addressed issues raised in Example 10 in the '571 Application, and applicants will continue to address in detail any rejection under § 102 or § 103 in which a Zaboklicki reference is applied.

### **Examples 11, 12, 15 and 16**

In Examples 11, 12, 15 and 16, the Examiner discusses applicants' use of the term “programming” in the 1981 and 1987 specifications. More specifically, Examples 11, 12, 15 and 16 assert that applicants cannot claim a 1981 priority date for claims including the term “computer programming,” because of an allegedly narrow definition of that term in the 1981 specification. The issues raised in Examples 11, 12, 15 and 16 are only relevant

if applicants rely on § 120 to obtain the benefit of their 1981 filing date. As applicants have not claimed priority to their 1981 application for any claims currently pending in this application, the issue is not relevant to the instant application. If and when the Examiner asserts that the issues found in Examples 11, 12, 15 and 16 are relevant to the claims pending in the instant application, applicants will respond at the appropriate time. Finally, applicants have fully addressed the “programming” issues raised in these examples in several prior responses filed in the ‘571 Application.

### **Example 13**

In Example 13, the Examiner discusses whether or not radio and television arts represent non-analogous arts. The Examiner states that applicants have previously asserted that the radio and television arts are non-analogous arts. The Examiner’s assertions in Example 13 do not form the basis for any rejection of or objection to any specific claim pending in the instant application. To the extent necessary, applicants will further address the issues raised by the Examiner in Example 13 if and when such issues are ever raised in the context of a rejection of or objection to a specific pending claim based on specific applied references in the identified arts.

### **Example 14**

In Example 14, the Examiner discusses issues related to a claim recitation (simultaneous and sequential) in the context of two of applicants’ copending applications (i.e., the ‘571 Application and Application Ser. No. 08/469,078). The Examiner’s assertions in Example 14 do not form the basis for any rejection of or objection to any specific claim pending in the instant application. To the extent necessary, applicants will further address the issues raised by the Examiner in Example 14 if and when such issues are ever raised in the context of a rejection of or objection to a specific pending claim. Additionally, applicants note that they have fully addressed issues related to the



Examiner's concerns regarding "simultaneous and sequential" in their January 28, 2002 Response filed in the '571 Application.

#### **Examples 17-20 and 23-26**

Examples 17-20 and 23-26 discuss various issues related to applicants' ability to obtain a priority date based on their 1981 application and the proper legal test to be applied when analyzing an applicants' ability to obtain a priority date under § 120. None of the issues discussed in Examples 17-20 and 23-26 is relevant to the instant application because applicants have not asserted a 1981 priority date for the claims pending in the instant application. Further, applicants have addressed the issues related to priority in detail in their responses filed in the '571 Application and Application Ser. No. 08/487,526.

#### **Example 21**

In Example 21, the Examiner describes and compares the technology disclosed by applicants in their 1981 and 1987 specifications and asserts that the technology disclosed in applicants' two specifications is "vastly different." While it is true that the 1987 application includes many enhancements and improvements, applicants maintain that the subject matter disclosed in their 1981 application is also disclosed in the 1987 application. Second, because applicants have not asserted a 1981 priority date for the claims pending in the instant application, applicants' 1981 specification and any comparison between applicants' 1981 and 1987 specifications are not relevant to the instant application. Finally, the issues raised in Example 21 have previously been addressed in the '571 Application. Applicants will continue to provide appropriate factual and legal arguments as to why they are entitled to a 1981 priority date in all cases where it is relevant.

#### **Example 22**

In Example 22, the Examiner discusses a perceived difficulty in interpreting terminology in applicants' claims in light of the 1981 and 1987 specifications. More specifically, the

Examiner asserts that certain terminology in applicants' claims takes on different interpretations when such terminology is read on different teachings from applicants' 1981 and 1987 disclosures. The alleged "problem" described in Example 22 is simply not applicable to the instant application because applicants have not asserted a priority date based on their 1981 application for any claim pending in the instant application. In the instant application, only the 1987 specification is used to support the pending claims. Accordingly, the issues raised by the Examiner in Example 22 are not relevant to the instant application. Further, applicants have fully addressed Example 22 in the '571 Application.

#### **Example 28**

In Example 28, the Examiner discusses a specific claim pending in the '571 Application (claim 56). Specifically, the Examiner questions applicants' written description support for the recitation "interactive ultimate receiver station" previously appearing in claim 56 of the '571 Application. Applicants maintain that both the 1981 and 1987 specifications unquestionably disclose "interactive receiver stations." *See, e.g.*, 1981 Specification col. 20, ll. 23-27, and "Local Input" in Figure 6D; 1987 Specification, p. 288, ll. 1-20. The Examiner's assertions in Example 28 do not form the basis for any rejection of or objection to any specific claim pending in the instant application. To the extent necessary, applicants will further address the issues raised by the Examiner in Example 28 if and when such issues are ever raised in the context of a rejection of or objection to a specific pending claim. Finally, applicants note that they have already fully addressed Example 28 in the '571 Application.

#### **Example 29**

Example 29 discusses limitations directed to combining images (e.g., where a "portion" of an image is "replaced" by a portion of another image) which are allegedly present in claims in applicants' '571 Application. Applicants maintain that applicants'

specifications broadly teach the combining of images. The Examiner's assertions in Example 29 do not form the basis for any rejection of or objection to any specific claim pending in the instant application. To the extent necessary, applicants will further address the issues raised by the Examiner in Example 29 if and when such issues are ever raised in the context of a rejection of or objection to a specific pending claim. Further, applicants have already fully addressed the issues raised in Example 29 in the '571 Application.

### **Example 30**

In Example 30, the Examiner discusses the publication date of article/reference by Gunn et al. Applicants acknowledge that the Gunn reference is a transcript from a conference in London that took place from March 26-28, 1980. But this information alone does not qualify the reference as prior art (i.e., it was unclear when the paper was published). However, since the mailing of the 7/17/02 Office action in the '571 Application, applicants received a copy of the Gunn reference that bears a Massachusetts Institute of Technology Library received stamp dated December 4, 1980. The Examiner also alleges in Example 30 that applicants have previously neglected to provide the Office with information regarding the publication dates of many references. Applicants have diligently supplied the Office with references as they have become known to applicants. In some instances, applicants were not provided with dates of certain references, so applicants were not able to provide the Office with dates for each and every reference identified on some of applicants' Information Disclosure Statements. Additionally, applicants submit that the discussion in Example 30 is not relevant to the instant application because the Gunn reference is not applied against any claim pending in the instant application.

### **Examples 31 and 33 - 36**

These examples are copies of arguments originally presented in the Office action mailed July 17, 2002, in applicants' copending application number 08/470,571 (Atty. Dkt. No. 05634.0261). In that Office action, the Examiner addressed statements made by applicants in the Interview Summary filed May 6, 2002 regarding proper application of 35 U.S.C. § 120. Applicants fully responded to the Examiner's arguments in the Response filed January 9, 2003 in the '571 application. Example 31 was originally presented on pages 9 - 10 of the Office action. Example 33 was originally presented on page 11. Example 34 was originally presented on page 12. Example 35 was originally presented on pages 12-13. Example 36 was originally presented on pages 13-14. Applicants consistently maintain that common subject matter is demonstrated when the claimed inventions are supported as set forth by the first paragraph of 35 U.S.C. § 112 in both the specification as filed and the parent specification. Applicants have fully addressed the issues raised in these Examples where they are relevant to the pending claims.

### **Example 32**

Example 32 the Examiner asserts that the disclosure of the 1981 specification was left behind by applicants' during the drafting of the 1987 specification. Applicants' disagree. Applicants assert that the subject matter for which applicants assert a 1981 priority date in the copending applications is contained in both the 1981 and 1987 specifications. The Examiner asserts that there are many differences between the 1987 specification and the 1981 specification. Applicants acknowledge that there is much new matter in the 1987 specification. However, this does not prohibit applicants from presently claiming what is disclosed in the 1981 specification, so long as the claims are also supported as required by 35 U.S.C. § 112 by the 1987 specification. The Examiner cites the following quotation.

A continuation-in-part application is not entitled to the benefit of the earlier filing date of its parent application where the changes included within the subsequent application is "new matter" which either alters the substance of the invention or makes the composition an invention for the first time, as opposed to the situation in which the subsequent application merely contains either a language change not affecting the meaning of the prior application or a specification which narrows the scope of that which was previously claimed.

*Indiana General Corp. v. Krystinel Corp.* 297 F.Supp. 427, 161 U.S.P.Q. 82, 94. (SDNY 1969) Applicants note that the "changes" in the above quote refers to changes in the claimed invention. In other words, in order to apply this test to deny a priority claim the Examiner must demonstrate that *claimed limitations* are not found in the parent application. This is the procedure used by the court in the next sentence of the quoted decision. Applicants maintain that the Examiner should apply such a test when a priority claim is at issue.

#### **G. Examiner's Summary Of Prior Art**

Section 13 of the Office action notes that Appendix IV of the Office action provides a summary of what the Examiner considers to be the more pertinent prior art. In light of the Examiner's review and summary of the art presented in Appendix IV, the Examiner appears to acknowledge that the art summarized fails to show or suggest any claim limitations that are not shown in the art applied in the rejections set forth in Sections 7, 10 and 12 of the Office action. As Section 14 and Appendix IV sets forth no rejections of the claims, no response by applicants is required by 37 C.F.R. § 1.111. Applicants reserve the right to further respond to the Examiners' summary of the art, if any of the assertions contained in the summary are relied on in any objection or rejection in the future.

In Appendix IV, the Examiner presents summaries of his understanding of certain features of the prior art. Applicants note these summaries are not prior art and cannot be

used directly to support claim rejections. Rather, the teaching of any properly available underlying reference must be applied to specific claim language to form a proper rejection. The Examiner's summary in Appendix IV is not directed against any specified claims.

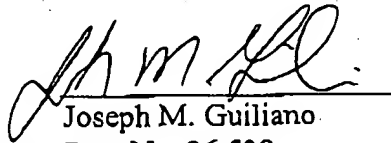
Part I of Appendix IV sets forth the Examiner's understanding of a typical TV station. Part II of Appendix IV sets forth the Examiner's understanding of automated TV recording devices. Part III of Appendix IV sets forth the Examiner's understanding of the uses of the vertical blanking interval. Part IV of Appendix IV sets forth the Examiner's understanding of remote control of TV stations. Part V of Appendix IV sets forth the Examiner's understanding of teletext transmission. Part VI of Appendix IV sets forth the Examiner's understanding of TV networks. Applicants note that the Examiner has relied upon over fifty references to support his summaries of television operations. The Examiner in his summaries picks and chooses features and elements from the numerous cited references to build his summaries of "conventional" systems. In Part VII of Appendix IV, the Examiner asserts that U.S. Patent 4,025,851 to Haselwood (Haselwood) illustrates a "conventional" network structure as constructed in Part VI and then appears to argue that all the features summarized in Parts I - V could obviously be incorporated in this structure. Applicants disagree with the Examiner's conclusions. The Examiner's is merely asserting that all features of all prior could be combined in any manner to form the Examiner's "conventional" structures. In an attempt to justify combining features of numerous references, the Examiner has constructed his own summaries. These summaries are not themselves prior art and cannot properly be used as the basis for modifying Haselwood. Should the teaching of Haselwood in combination with any actual prior art be applicable to any of applicants' pending claims, an explanation of such combination should be presented in a rejection of such claims. A proper explanation must include the justification for making such a combination under the *controlling legal authority* cited above. In the absences of such a rejection, applicants

request that Appendix IV be withdrawn. Applicants reserve the right to demonstrate how the Examiner's summaries presented in Appendix IV fail to teach or suggest any particular claim elements, should such a rejection be presented.

### III. CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. Reconsideration and allowance of the instant application are respectfully requested.

Respectfully submitted,



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